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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUSAKU FUJII and TAKASHI SHINZAKI

Appeal 2008-0362
Application 09/425,736
Technology Center 2100

Decided: March 4, 2008

Before JAMES D. THOMAS, ALLEN R. MACDONALD, and JAY P. LUCAS, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1, 3-12, and 14-22. We have jurisdiction under 35 U.S.C. § 6(b).

Representative independent claim 1 under appeal reads as follows:

1. An illegal access discriminating apparatus that is placed in advanced of a user authentication system using biometrics which needs user information comprised of ID information and organic information comprising:

a first storing unit for temporarily storing the latest pair of ID information and organic information inputted by a user when the user is being authenticated,

a second storing unit for storing pairs of ID information and organic information which were inputted by arbitrary users within predetermined time, wherein said ID information and organic information is transferred from said first storing unit to said second storing unit after each authentication;

a comparing and collating unit for comparing and collating the latest inputted ID information and organic information with all of ID information and organic information stored in said second storing unit which were inputted and not previously registered in the past; and

a control unit for discriminating authentication demand by an attacker by counting the number of said comparing-collating results which satisfy predetermined conditions and judging authentication demand as the one by an attacker if said counted number exceeds predetermined value.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

McNair	US 5,276,444	Jan. 4, 1994
Moussa	US 6,035,406	Mar. 7, 2000
Gressel	US 6,311,272	Oct. 30, 2001

The Examiner rejected claims 1, 5, and 12 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Moussa and McNair.

The Examiner rejected claims 3-4, 6-11 and 14-22 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Moussa, McNair, and Gressel. [1]

Appellants contend that the claimed subject matter would not have been obvious. More specifically, Appellants contend that the Moussa reference relied upon by the Examiner fails to teach (1) a second storing unit or (2) a comparing and collating unit as required by the claims (App. Br. 10-11 and Reply Br. 4-5).

We reverse.

ISSUE(S)

Have Appellants shown that the Examiner has failed to establish that Moussa describes (1) a second storing unit or (2) a comparing and collating unit as required by the claims?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Moussa

Moussa describes a user authentication system and process using stored ID and organic information which is compared to input ID and organic information (col. 1, ll. 24-33, and col. 4, ll. 56-64).

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[1] Contrary to Appellants' contention (Reply Br. 3:4-5), the rejection of claims 11 and 22 under 35 U.S.C. § 112, was withdrawn by the Examiner (Ans. 16).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR.*, 127 S. Ct. 1727, 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

Claims 1, 5, and 12

The Examiner correctly shows where a storing unit and a comparing unit appear in the Moussa prior art reference. However, Appellants correctly point out the functions performed by these units do not correspond to the functions recited in claims 1, 5, and 12. (See App. Br. 10-11 and Reply Br. 4-5.)

We find that the Moussa reference is directed to the prior art user authentication system briefly described by Appellants at page 1, lines 20-27, of the Specification. Appellants' own system and method starts with such a prior art system as described at page 18, lines 4-21, of the Specification. Appellants' service providing system 10 clearly must include a unit for

storing (registering) legal users and a comparing unit for authentication of legal users. This is a prior art service providing system to which Appellants have added an illegal access discrimination apparatus which includes the claimed first and second storing units and the claimed comparing and collating unit (see item 16 of Figure 1). These claimed units perform different functions than the similar units within the prior art item 10 of figure 1. It is the authentication functions performed within item 10 that correspond to the teachings of Moussa, not Appellants' claimed "illegal access discriminator" which build off this authentication process. The latter are not found in Moussa, and the McNair reference does not correct the failures of the Moussa reference.

On the record before us, it follows that the Examiner erred in rejecting Claims 1, 5, and 12 under § 103(a).

Claims 3-4, 6-11, and 14-22

The Gressel reference does not correct the failures of the Moussa and McNair references.

Since Claims 3-4, 6-11, and 14-22 are narrower than Claims 1 and 12 from which they depend, it also follows that those claims were not properly rejected under § 103(a).

CONCLUSION OF LAW

(1) Appellants have established that the Examiner erred in rejecting claims 1, 3-12, and 14-22 as being unpatentable under 35 U.S.C. § 103(a).

(2) On this record, claims 1, 3-12, and 14-22 have not been shown to be unpatentable.

DECISION

The Examiner's rejection of claims 1, 3-12, and 14-22 is reversed.

REVERSED

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